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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/526,208 | 09/16/2005 | Bjarne H Dahl | 2815-0299PUS1 | 7493 |
| 2292 7590 06/04/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| EXAMINER | | | | |
| CHANG, CELIA C | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1625 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 06/04/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/526,208

Applicant(s)

DAHL ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-25 and 33-39 is/are pending in the application.
4a) Of the above claim(s) 35-39 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 22-25, 33-34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

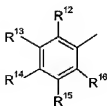
DETAILED ACTION

1. Amendment and response filed by applicants dated Mar. 4, 2009 have been entered and considered carefully.

Claims 1-21, 26-32 have been canceled. Claims 22-25, 33-34 are pending. Claims 35-39 stayed withdrawn from consideration. It has been clearly stated in the restriction requirement that any process of use claim that can be rejoindable must depend solely on the allowable product and *free* from all 112 issues. Please note that no evidence that all the claimed compounds are able to treat, prevent or alleviate *all* disorders ranging from skin allergy to cancer, arthritis, brain oedema, diarrhea, glaucoma, ulcer etc. i.e. disorders of diverse etiology and symptoms. For any one compound to have efficacy in all the disorder as listed in the claims would be incredible. Therefore, none of claims 35-39 are rejoindable.

2. Claims 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The amendment of the claims i.e.



represents the ring system A, which is selected from the group consisting of 2-chloro-phenyl, 2-fluoro-phenyl, 2-trifluoromethyl-phenyl, 2,3-dichloro-phenyl, 2,4,6-trichloro-phenyl, 2,6-dichloro-phenyl, 3,4-dichloro-phenyl, 3-fluoro-4-chloro-phenyl, 3-trifluoromethyl-4-chloro-phenyl, 3,5-dichloro-phenyl, 3,5-difluoro-phenyl, 3-fluoro-5-trifluoromethyl-phenyl, 3,5-bis-trifluoromethyl-phenyl and 4-chloro-phenyl;

lacks antecedent basis in the specification as originally filed, thus, are new matter. The moieties

R¹²-R¹⁶, are two of the moieties independently of each other represent halo, trifluoro-methyl, nitro, alkyl, or alkoxy; and the remaining three of the R¹²-R¹⁶ represent hydrogen (see paragraph bridging p.7-8 specification). Nowhere in the specification were a subgeneric scope as amended supra found. Therefore, the claims contain NEW MATTER. Removal of new matter is required. In re Russmussen 210 USPQ 325.

3. After removal of new matter and the claims are reverted to the previous version, the previous rejections of:

--Claims 21-26, 33-34 are rejected under 35 U.S.C. 102(a) as being anticipated by Christophersen et al. WO 02/39987 (recited on 1449) supplemented with CA 136:380081, see anticipating structure by CAS.

--Claims 22-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Christophersen et al. WO 98/47879 (recited on 1449). See p.27 line 22, p.28 line 13.

--Claims 21-26, 33-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dahl et al. WO 00/24707 (recited on 1449), see p.34-36 claim 6, tetrazolyl phenyl and tetrazolyl-biphenyl species.

-- Claims 21-26, 33-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al. WO 00/24707 or Christophersen et al. WO 98/47879 in view of Dahl et al. WO 00/24707 supplemented by CA132:308142.

-- Claims 21-26, 33-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al. WO 00/24707 or Christophersen et al. WO 98/47879 in view of Dahl et al. WO 00/24707 supplemented by CA132:308142.

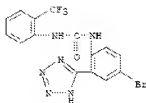
-- Claims 21-26, 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,297,261; US 6,706, 749; US 6,696,475 or WO 2004/012733 supplemented with CA 140:175143.

-- Claims 21-26, 33-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al. US 6,706,749 or US 6,696,475 or Christophersen et al. US 6,297,261 in view of Dahl et al. US 6,706,749 or US 6,696,475 supplemented by CA132:308142.

are maintained for reason of record. In addition, the 102(f) issues of claims 21-26, 33-34 and claims 3 or 13 US 6,297,261; claim 6 US 6,706,740 or claim 6 of US 6,695,475 must be

resolved. The obviousness type double patenting over claims 1-15 of US 6,297,261; claims 1-18 of US 6,706,749 or claims 1-13 of US 6,696,475 are also maintained for reason of record.

4. Even taking into the consideration of the current amendment, that the system A is 2-trifluoromethyl-phenyl, the amended claims 22-23 does not obviate the 103(a) rejection or the obviousness type double patenting over US 6,696,475. Please note that '475 claimed a specific species of claim 6, col. 30, lines 22-23 which is the following compound:



The difference between the prior issued species and the instant amended claims is that instead of a bromo-substitution as R⁴, the instant R⁴ is CONR^bR^d, R^b is H, R^d is phenyl (optionally substituted). The issued '475, claim 1, the same R⁴ moiety was optionally claimed to be halogen or CON(R⁹)₂, wherein R⁹ is H or aryl, therefore, CON R^bR^d of the instant claims is an optional choice of the issued species Br. Therefore, the current amendment does not obviate either the 103(a) issues or the obviousness type double patenting of the issued patents. The illustration is only one example to delineate the obviousness nature based on the generic scope and the issued species claims. All the US patents recited in the record can exhibit such obvious substituent equivalency but will not be exhaustively listed. Applicants are urged to consult the clear delineation of the rejections of the previous office action. For applicants' convenience, the chemical structure of some of the named compounds of the US 6,297,261 and US 6,706,740 are hereby provided (please note that the listing is not exhausted delineation of all the compounds only selected variations as examples).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
May 28, 2009

/Celia Chang/
Primary Examiner
Art Unit 1625